

REMARKS/ARGUMENTS

Applicant appreciates the thorough examination of the present application, as evidenced by the first Official Action. Initially, Applicant notes that the first Official Action objects to the dependency of Claim 54, and rejects Claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite. In response thereto, Applicant has amended Claims 10 and 54 to further clarify the claimed invention. And in view of the aforementioned amendments, Applicant respectfully submits that the objection to Claim 54 and rejection of Claim 54 under § 112, second paragraph, are overcome.

In addition to the foregoing, the first Official Action also rejects Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2006/0025141 to Marsh et al., in view of U.S. Patent Application Publication No. 2003/0154293 to Zmolek. The Official Action then rejects the remaining claims, namely Claims 6, 15, 24, 33, 42 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Marsh in view of Zmolek, and further in view of U.S. Patent Application Publication No. 2004/0024879 to Dingman et al. As explained below, however, Applicant respectfully submits that the claimed invention is patentably distinct from Marsh, Zmolek and Dingman, taken individually or in combination; and accordingly traverse these prior art rejections of the claims. Nonetheless, to advance prosecution of the present application, Applicant has amended various ones of the claims to further clarify aspects of the present invention. In view of the amendments to the claims and the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application.

A. Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 are Patentable

The first Official Action rejects Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 as being unpatentable over Marsh, in view of Zmolek. Briefly, Marsh discloses a soft switch for providing wireless PBX (private branch exchange) voice services to a local area network (WLAN) is used to extend PBX functionality to the cellular domain. As disclosed, a dual-mode remote unit is capable of receiving signals both in the WLAN and the cellular system, where the cellular system includes both a data-bearing path and a voice-bearing path. In this regard, when

the dual-mode remote unit is within the WLAN, it communicates both VoIP (voice over IP) signaling and SIP (Session Initiation Protocol) control signaling over the WLAN. But when the remote unit is outside the WLAN, it communicates voice signaling over the voice-bearing path of the cellular network using a standard cellular voice channel, and in parallel, uses the data-bearing path of the cellular network to transmit SIP control signaling.

Amended independent Claim 1 recites an apparatus for establishing a communication session with a terminal. As recited, the apparatus includes a processor located in a network across which an originating client is configured to communicate. The processor is configured to receive a connection request, and thereafter send a trigger to the terminal independent of the network. As also recited, the processor is configured to receive a registration message in response to the trigger to thereby register the terminal with the processor, and identify the terminal across the network such that the communication session is capable of being established with the terminal based upon the identity of the terminal across the network.

In contrast to amended independent Claim 1 in particular, none of the cited references, taken individually or in any proper combination, teach or suggest an apparatus including a processor triggering a terminal (independent of a network) to thereby register with the processor and identify the terminal across the network so that a communication session may be established with the terminal across the network. That is, in contrast to amended independent Claim 1, neither Marsh nor Zmolek (nor Dingman), taken individually or in any proper combination, teach or suggest triggering a terminal independent of a network across which an originating client communicates, the terminal being triggered to thereby register with the processor and identify the terminal across the network so that a communication session may be established with the terminal based on the identity of the terminal across the network.

Initially, Applicant notes that although original independent Claim 1 included a typographical error reciting triggering the terminal “independent of the location of an originating entity,” original independent Claims 10, 19, 28, 37 and 46, and now amended independent Claim 1, instead recite triggering the terminal or identifying the terminal “independent of the network” for which a communication session may ultimately be established. In rejecting all of independent Claims 1, 10, 19, 28, 37 and 46, however, the Official Action appears to have only

Appl. No.: 10/797,765
Amdt. dated June 5, 2007
Reply to Official Action of March 6, 2007

considered the “independent of the location of an originating entity” feature of independent Claim 1. And considering the triggering feature of amended independent Claim 1, Applicant respectfully submits that none of Marsh, Zmolek or Dingman, taken individually or in any proper combination, teach or suggest triggering the terminal or identifying the terminal independent of the network for which a communication session may ultimately be established. For the particular triggering independent of the location of the originating entity feature, the Official Action cites Zmolek (paragraph 0005) for disclosing performing SIP signaling independent of the location of the terminal. But although Zmolek may disclose reaching a contactee via a single, location-independent address, nowhere does Zmolek teach or suggest sending a trigger to a terminal independent of the network for which a communication session may ultimately be established with the terminal.

The above notwithstanding, Applicant also notes that the Official Action appears to have misinterpreted amended independent Claim 1 in that the claim recites that the terminal is triggered to thereby identify the terminal across the network (and in various independent claims to also register with the processor). Nowhere, however, does the Official Action cite any of Marsh, Zmolek or Dingman for disclosing triggering a terminal to thereby identify the terminal across the network (thereby enabling a communication session with the terminal across the network based on the respective identity). The Official Action alleges that Marsh discloses a public-switched telephone network (PSTN) initiating a cellular call with a dual-mode subscriber device, and that this corresponds to the triggering feature of the claimed invention (albeit without the trigger being independent of the network). But nowhere does Marsh teach or suggest that the PSTN initiates the cellular call to thereby register the subscriber device with the PSTN and identify the subscriber device across a network.

Applicant therefore respectfully submits that amended independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Marsh and Zmolek, taken individually or in combination. Applicant also respectfully submit that amended independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of amended independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be

Appl. No.: 10/797,765
Amdt. dated June 5, 2007
Reply to Official Action of March 6, 2007

established. As such, Applicant also respectfully submit that amended independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Marsh and Zmolek, taken individually or in combination, for at least the same reasons given above with respect to amended independent Claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 as being unpatentable over Marsh, in view of Zmolek, is overcome.

B. Claims 6, 15, 24, 33, 42 and 51 are Patentable

The Official Action also rejects Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Marsh in view of Zmolek, and further in view of Dingman. As explained above, amended independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Marsh, in view of Zmolek. Applicant respectfully submits that Dingman does not cure the deficiencies of Marsh and Zmolek. That is, even considering Dingman, none of Marsh, Zmolek or Dingman, taken individually or in combination, teach or suggest the aforementioned terminal-triggering feature, as recited by the claimed invention. And one skilled in the art still would not be motivated to modify Marsh, or Marsh in view of Zmolek, with the teachings of Dingman to disclose the claimed invention. Thus, for at least the reasons given above with respect to amended independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Marsh in view of Zmolek, and further in view of Dingman.

Applicants accordingly submit that the rejection of Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Marsh in view of Zmolek, and further in view of Dingman, is overcome.

Appl. No.: 10/797,765
Amdt. dated June 5, 2007
Reply to Official Action of March 6, 2007

CONCLUSION

In view of the amendments to the claims and the remarks presented herein, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Andrew T. Spence
Registration No. 45,699

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON JUNE 6, 2007.

LEGAL02/30394816v1